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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/580,813	05/26/2000	Thomas M. Keeley	460870.90018	9113

26710 7590 06/14/2005

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EXAMINER

NGUYEN, MAIKHANH

ART UNIT PAPER NUMBER

2176

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/580,813

Applicant(s)

KEELEY, THOMAS M.

Examiner

Maikhanh Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: RCE filed 04/06/2005 to the original application filed 05/26/2000.
2. Claims 1-16 are currently pending in this application. Claims 1-4, 8, 10, and 15 have been amended. Claims 1 and 10 are independent claims.

Request Continuation for Examination

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/06/2005 has been entered.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
5. Claims 1-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-16 need to be directed towards a "program tangibly embodied in a computer readable medium."

Claims 1-16 are claiming a program per se and not tangibly embodied in a computer readable medium for causing the computer to execute in a practical manner. Claims 1-16 thus are program per se and held nonstatutory.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16 remain rejected under 35 U.S.C. 103(a) as being unpatentable over **Hugh** (U.S. 6,256,032 – filed 01/2000) in view of **Marpe et al.** (U.S. 6,671,693 – filed 11/1999).

As to independent claim 1:

- a. Hugh teaches a program for the organization of ideas using an electronic computer (*e.g., organizing and processing pieces of interrelated information 'or thoughts' using a digital computer; Abstract*), the electronic computer having a user input device and a graphics display (*e.g., graphical user interface to facilitate user interaction; Abstract*), the program comprising instructions executed on the electronic computer to:

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- (i) accept text identified ideas from a user via the user-input device (*e.g., the “key words” of a thought ...inputted by the user; col.6, lines 15-24*);
 - (ii) hierarchically display representations of the text identified ideas on the graphic display (*e.g., a graphical presentation of a portion of the matrix is displayed ... according to the thoughts ...hierarchical-based approaches; col.2, line 45-col.3, line 16*) as organized into levels defined by common hierarchical dependency (*e.g., traditional hierarchical structures and “desktop” metaphors compel users to organize their thought processes ...hierarchical metaphors for information management; col.2, lines 1-13*);
 - (iii) accept from the user numeric priorities for the text identified ideas of at least one level (*e.g., a priority number set by the user indicates the relative importance of a particular thought; col.7, lines 11-17*); and
 - (iv) hierarchically arrange the text identified ideas of the at least one level on the graphic display (*e.g., the placement of the thoughts reflects second-level relations ... graphical presentation; col.7, line 64-col.8, line 11 & arrange portion of their information in a traditional hierarchical manner; col.28, lines 35-52*) according to the numeric priorities (*e.g., priority 230; col.7, lines 11-17 & thought lists ...priority levels; col.25, lines 26-37*).
- b. Hugh, however, does not explicitly teach “accept at least one hierarchy instructions from the user via the user-input device, the hierarchy instructions relating the accepted text identified ideas in dependencies.”

- c. Marpe teaches accept at least one-idea hierarchy instructions from the user via the user-input device, the hierarchy instructions relating the accepted text identified ideas in dependencies (*e.g., Exploring or pre-writing is the process of brainstorming and taking unstructured notes ...relation among ideas, groups related ideas and constructs small hierarchical structures ...Organizing is the process of putting those notes or ideas in order, in the form of an outline or a hierarchy; col.12, lines 11-61 & receiving data from multiple users in a plurality of categories, wherein the data is organized in a hierarchy of categories; col.54, lines 56-64*).
- d. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Hugh and Marpe because Map's teachings would have provided the capability for translating the abstraction of content and the relations of a hierarchical structure into a sequence of words, sentences, paragraphs, sections, chapters, and illustrations.

As to dependent claim 2:

Hugh teaches the hierarchically displayed representation of the text identified ideas are text displayed in a text outline according to the hierarchical dependencies of ideas associated with the text, the text outline including paragraphs arranged beneath other paragraphs on which they depend; and wherein the paragraphs of a level are ordered according to the numeric priorities of the text identified ideas to which they are related (*col.30, lines 13-38 & Fig.16*).

As to dependent claim 3:

Hugh teaches the displayed representations of the text identified ideas are node symbols arranged in a tree according to their hierarchical dependencies, the tree structure including branches visually connecting node symbols to other node symbols on which they depend; and wherein the node symbols of a level are ordered according to the priorities of the ideas to which they are related (*col.5, lines 10-13/ col.7, lines 11-51/ col.9, lines 12-29 and col.25, lines 26-37*).

As to dependent claim 4:

Hugh teaches provide a list of representations of identified ideas of a level (*col.29, lines 8-24*) and wherein priorities are assigned by the user by changing the order of the representations of identified ideas within the list of representations of text identified ideas (*col.7, lines 10-17 and col.14, lines 9-23*)

As to dependent claim 5:

Hugh teaches allow changing of order of representations of identified ideas by selection of a given representation of an identified idea as displayed on the graphics display using the user input device and moving the representations of the identified idea within the list of representations of text identified ideas as displayed on the graphic display device using the user input device (*col.6, lines 45-65 & col.14, lines 9-23*).

As to dependent claim 6:

Hugh teaches when the representation of an identified idea is moved within the list of representations of text identified ideas to modify the numeric priority of at least one idea text identified idea so that the numeric priorities of all identified ideas in the list of

representations of text identified ideas remain monotonically decreasing (*col.23, line 43-col.24, line 24*).

As to dependent claim 7:

Hugh teaches provide a list of representations of text identified ideas of a common hierarchical level and to display a slide control for each text identified idea in the list of representations of text identified ideas that may be manipulated by the user input device to enter the numeric priorities (*col.24, line 1-24*).

As to dependent claim 8:

Hugh teaches decrease the numeric priority of all specific identified ideas in the list of representations of text identified ideas to beneath a given identified idea to a value less than a value of the numeric priority of the given text identified idea (*col.7, lines 11- 17 & lines 40-51*).

As to dependent claim 9:

Hugh teaches increase the value of the numeric priority value of all specific text identified ideas in the list of representations of text identified ideas above a given text identification idea to a value at least equal to a value of the numeric priority of the specific text identified idea (*col.8, lines 55-col.9, line 11*).

As to independent claim 10:

- a. The rejection of independent claim 1 above is incorporated herein in full.
Additionally, claim 10 further recites “after acceptance of a given text identified idea from the user in at least one predefined level, prompt the user as to additional

text identified ideas for inclusion in a next level having ideas dependent on the idea of the given text identified idea.”

- b. Hugh teaches after acceptance of a given text identified idea from the user in at least one predefined level, prompt the user as to additional text identified ideas for inclusion in a next level having ideas dependent on the idea of the given text identified idea (*col.8, line 55- col.9, line 49*).

As to dependent claim 11:

Hugh teaches the predefined categories are issue, position and argument and wherein the user is prompted with possible arguments when the given text identified idea is a position and the user is prompted with possible positions when the given text identified idea is an issue (*col.24, line 45-col.25, line 11*).

As to dependent claim 12:

Hugh teaches the user is prompted with a set of open-ended questions (*col.21, lines 36-54*).

As to dependent claim 13:

Hugh teaches the open-ended questions are augmented by text from the given text (*col.21, lines 36-54*).

As to dependent claim 14:

Hugh teaches allow the user to select from a set of predefined generic identified ideas and hierarchies and to provide an editor for editing the predefined generic identified ideas and hierarchies (*col.7, lines 28-51 & col.22, lines 13-38*).

As to dependent claims 15-16:

They include the same limitations as in claims 2-3, and are similarly rejected under the same rationale.

Response to Arguments

7. Applicant's arguments filed 07/19/2004 have been fully considered but they are not persuasive.

The Examiner believes that the combination of Hugh and Marpe shows how the references meet the limitations as claimed by Applicant.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Jurovics et al.	U.S. Patent No. 5,675,820	issued: Oct. 7, 1997
Forcier.	U.S. Patent No. 6,502,114	issued: Dec. 31, 2002
Kanevsky et al.	U.S. Patent No. 6,426,761	issued: Jul. 30, 2002
Gharavy	U.S. Publication 2002/0059272 A1	Pub. Date: May. 16, 2002

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached on (571) 272-4124.

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The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MN

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
6/9/2005